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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,410	02/08/2002	Bernard O. Domries		1683

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EXAMINER

BATSON, VICTOR D

ART UNIT

PAPER NUMBER

3671

DATE MAILED: 09/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

SW

Office Action Summary

Application No.

10/071,410

Applicant(s)

DOMRIES, BERNARD O.

Examiner

Victor Batson

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-- Th MAILING DATE of this communication app ars on th cov r sheet with the correspond nc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Claim Rejections - 35 USC § 112

Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1 lines 2-3, the phrases "without exceeding normal limits for height, width and length" (lines 2-3) and "having a width less than the maximum legal width allowed for transport on a public roadway without special precautions for wide loads" (lines 3-5) and "to a road-legal location" (line 21) and "that is road-legal" (line 23) are considered indefinite since "normal limits", "maximum legal" and "road legal" are terms whose meanings can and do change. Therefore, it is not possible to determine the meets and bounds of the claim. Similarly, the phrases in claim 7, "having a width less than the maximum legal width allowed for transport on a highway without special precautions for wide loads" (lines 2-4), "that is road-legal in both height and width" (lines 18-19). Similarly, in claim 6 lines 5-7, the phrase "whereby transport may be accomplished without escort, special permits or "wide load" signs and flashing lights" is considered indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,7,8 are rejected under 35 U.S.C. 102(b) as being anticipated by Moore (6,003,615).

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Moore discloses a farm implement comprising a frame 12, left wing 18', and right wing 18, with soil working implements and a hydraulic system (comprising hydraulic cylinders 44) for lifting the wings.

Claims 1,2,4,5,7,8,11,12,13 are rejected under 35 U.S.C. 102(b) as being anticipated by Meek et al. (5,921,325).

Meek et al. discloses a farm implement comprising a frame 12, left wing 16, and right wing 14, with soil working implements and a hydraulic system (comprising hydraulic cylinders 58) for lifting the wings as shown in figures 5-7. It is noted that Meek et al. further discloses wheels 20 and four lifting mechanisms (considered the combination of hydraulic cylinders and linkage used to lift the wings) powered by the hydraulic system as shown in figures 5-7. Concerning claim 12, Meek et al. discloses the use of hold-down mechanism operating in both a locked position and a flex position (col 5 line 50-col 6 line20). Concerning claim 5, members 24 & 26 are considered the support arm and member 46 is considered the hold-down box.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3,6,9,10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meek et al. (5,921,325).

Meek et al. discloses a farm implement as described previously, but lacks specifying that the wheels are capable of being raised or lowered.

Concerning claim 6 although Meek et al. does not specify a maximum width of eight feet or a maximum height of fourteen feet or less, Meek et al. does disclose forming the device with a width and height that will allow it to be in compliance with road width requirements and so that it will meet gate clearance requirements (col 1 lines 41-55). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify the device of Meek et al. so that it has a maximum width of eight feet and a maximum height of fourteen feet or less so that it can be in compliance with road requirements and so that it can meet gate clearance requirements as taught by Meek et al..

Concerning claim 10, the examiner takes Official Notice that it is notoriously old and well known in the art to make disk gangs adjustable relative to the path of travel. This allows the spacing between multiple implements to be adjusted depending on the operation being performed or the crop being planted.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Meek et al., by providing the ability to adjust the implements relative to the path of travel since such adjustability is notoriously old and well known in the art as it allows for adjustment of the implements depending on the operation being performed or the crop being planted.

Concerning claims 3 & 9, Meek et al. lacks specifying the bore and stroke of the hydraulic cylinders. It would have been obvious to one having ordinary skill in the art at

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the time the invention was made to provide the hydraulic cylinders with a bore of approximately three inches and a stroke of less than twelve inches since it has been held that discovering an optimum value of a result effective variable involves only routing skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Response to Arguments

Applicant's arguments filed 6/25/03 have been fully considered but they are not persuasive.

Applicant argues that the rejection based on 35 U.S.C. 112 is traversed because the terms in the claims regarding the invention being road legal are not indefinite. Applicant however admits that the meaning of *road legal* can change over time and vary between countries and even between jurisdictions. Applicant further states that precise dimensions cannot be given because there is no common agreement on these dimensions. This is the very essence of being indefinite. One of ordinary skill in the art would have no idea how to precisely make and use the invention since the claimed terms have no set dimensions, and since even a particular set of road legal dimensions could change from year to year and from jurisdiction to jurisdiction. It is unclear if applicant is claiming past, present or future road legal dimensions.

Additionally, it is noted that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's arguments, the recitation "capable of being transported on highways" has not been given patentable weight because the recitation occurs in the

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preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

In response to applicant's argument that Meek is not intended for highway transport, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Clearly if the device of Meek is capable of being transported over ground or on a roadway, it is "capable" of being transported on a highway.

The examiner further notes that the idea of folding or modifying an agricultural implement to allow for highway transport is notoriously old and well known in the agricultural art as set forth in the cited prior art (see conclusion below).

Final Rejection

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art of record including Hornung (3,620,550), Calkins (3,651,870), Ankenman et al. (3,990,521), Boone et al. (4,034,623), Bucher et al. (4,128,131), Friggstad (4,355,689), Shoup (4,364,581), Hadler et al. (4,415,043), Summach et al. (4,821,809), McKemie (4,971,154), Reiber et al. (6,112,827), Friggstad (6,371,215), Friggstad (6,374,921), Shoup (6,408,950) and Friggstad (6,550,543), discloses folding farm implements specifically for highway transport.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor Batson whose telephone number is (703) 305-6356. The examiner can normally be reached on Monday through Friday (except Wednesday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Will can be reached on (703) 308-3870. The fax phone numbers for

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the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-3597 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1115.

September 5, 2003



Victor Batson
Primary Examiner
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